1   [counsel listed on signature page]

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8   UNITED STATES DISTRICT COURT

9   NORTHERN DISTRICT OF CALIFORNIA

10   SAN FRANCISCO DIVISION

11   ORACLE AMERICA, INC.   Case No. CV 10-03561 WHA

12   Plaintiff,   **SUPPLEMENTAL JOINT
                                             STATEMENT REGARDING
13   v.   ORACLE PRODUCTS
                                             PRACTICING PATENTS**
14   GOOGLE INC.

15   Defendant.
                                             Dept.: Courtroom 8, 19th Floor
16   Judge: Honorable William Alsup

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1   Pursuant to the Court's January 31, 2012 Order Regarding Patent Marking Dispute (ECF

2 No. 707) and the agreement between the parties as set forth in their December 30, 2011 Joint

3 Statement Regarding Supplemental Order Regarding Patenting Marking (ECF No. 661), Plaintiff

4 Oracle America, Inc. ("Oracle") and Defendant Google Inc. ("Google") hereby submit the

5 following statement regarding Oracle products, Oracle-licensed products, Sun products, and Sun-

6 licensed products ("Oracle Products") that practice or have practiced the asserted claims of the

7 patents-in-suit ("claims-in-suit").

8   **I.   STIPULATIONS**

9   In order to narrow the issues to be addressed at trial, the parties have agreed on a number

10 of stipulations. Almost all of the disputes that the parties have regarding whether Oracle practices

11 the asserted claims are based on the same technical arguments underlying the parties' respective

12 positions on the alleged infringement of the patents by the accused Android instrumentalities.

13 Accordingly, as to many of the patents, the parties have worked on conditional stipulations that

14 tie the issues together: *i.e.*, if the accused Android functionality infringes, then Oracle's products

15 practice the patent.

16   The parties agree that as to the unconditional stipulation they have reached, the stipulation

17 may be used in all phases of trial, as it is not conditional on the resolution of the dispute between

18 the parties.

19   The parties have not been able to agree upon the evidentiary effect of the conditional

20 stipulations. The positions of the parties are as follows:

21   Oracle argues that in order for such a conditional stipulation to be fair, it must be effective

22 for *all* purposes as the Court suggested (ECF No. 641) and the parties agreed (ECF No. 661), and

23 be applied to secondary considerations of nonobviousness in the patent liability phase of the trial

24 as well as to marking or injunction issues in later phases; an explanation and limiting instruction

25 from the Court would prevent any jury confusion. Oracle maintains that to streamline the trial

26 and avoid the need for "infringement-like" analysis or testimony on Oracle's products, the

27 conditional stipulations *must* be effective in the patent liability phase of the trial. Otherwise, just

28 as the Court has tried to prevent (ECF No. 707), Google will indeed "have it both ways" and

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1   benefit from this procedure in the damages phase without having to admit items that may hurt

2   Google in the liability phase. The parties agreed to "jointly submit to the Court a list of the

3   Oracle Products that they stipulate practice the asserted claims, which shall have the effect of

4   establishing that fact for all purposes at trial" (ECF No. 661), and if Google is unwilling to accept

5   that the conditional stipulations apply to all phases of the trial, then they are not actually

6   stipulations according to the agreed-upon procedure approved by the Court.

7   Oracle notes that the agreed-upon procedure concerns only Oracle's practice of the patents

8   and not the marking issue, so no stipulation regarding marking "must" be made, as Google

9   suggests below. The legal effect of Oracle's discovery admissions on the marking issue cannot

10   be addressed until after the patent liability phase of the trial, given the conditional stipulations

11   below.

12   Google believes that it and Oracle have unbridgeable technical disagreements as to what

13   does and does not infringe the patents, as demonstrated by their expert reports on infringement

14   issues. In an attempt to simplify the proof required in the case, Google has agreed to allow the

15   jury to be the arbiter of who is right on coverage of the claims as to both the accused

16   instrumentalities and the Oracle products (with one small exception for the '520 patent, where the

17   technical dispute encompasses issues beyond those raised by Oracle's infringement theories as to

18   the Google accused instrumentalities). It would be both confusing to the jury, and prejudicial to

19   Google, to be told that they can presume that Oracle practices its patents if they end up deciding

20   that Google infringes those patents. Much mischief could be created by the use of this stipulation

21   outside the context for which it is intended, perhaps even leading the jury to believe that Google

22   agrees with Oracle's technical arguments for infringement—which is precisely the opposite of the

23   truth.

24   With respect to Oracle's claim about the potential savings in the presentation of evidence,

25   the only issue to which Oracle has pointed in meet and confer discussions or here is that of the

26   secondary considerations of non-obviousness of commercial success of its products. First, that

27   issue would only arise if Google presses a claim at trial that a particular patent is invalid as

28   obvious. Second, if Oracle wishes to argue that the alleged inventions of its patents are

1   responsible for the commercial success of its products, it would need to present evidence of a

2   nexus between the commercial success and those patents. The evidentiary showing there would

3   overlap with, and dwarf, any evidence that Oracle would contemplate putting on regarding how

4   its products allegedly practiced the patents.

5   Nor is Google "trying to have it both ways" as Oracle claims. It has worked with Oracle

6   to identify technical issues despite its evidentiary objections to what Oracle can prove (and the

7   stipulations here do not waive any objections to evidence that Oracle seeks to introduce at trial).

8   It has stipulated unconditionally as to the patent and products where the parties have no remaining

9   technical issues, which fact is established for all purposes at trial. And Oracle gains the ability to

10 say that its products practice any infringed patents during Phase 3 of the trial without putting on

11 any additional evidence, which allows trial to be streamlined in a fair manner. But without

12 actually agreeing with Oracle as to the technical merits of its infringement read, Google cannot

13 agree to Oracle seeking to imply to the jury that, in effect, if Oracle practices its patents, Google

14 must be an infringer. Indeed, it is Oracle that is trying to have its cake and eat it too. Google

15 believes that Oracle must stipulate that the products enumerated below were not marked with the

16 patent numbers pursuant to 35 U.S.C. § 287—a position with which Oracle does not disagree

17 factually. But Oracle has refused to include those facts as part of the stipulation. Google believes

18 that it would be appropriate for the parties to remove those factual issues from the need for

19 presentation at trial as well, and thinks this stipulation would be an appropriate place to do so.

20   **A.   '702 patent**

21   **1.   Java OS 1.1 products**

22   The parties stipulate that Java OS 1.1 (and variants, including Java PC) practice the

23 asserted claims of the '702 patent.

24   **2.   Java Card platform 2.1 products**

25   There is a dispute between the parties as to the proper application of the claims of the '702

26 patent. Oracle argues that the .CAP file created by the use of Java Card includes "reduced class

27 files" as the phrase was construed by the Court, because the removal of additional elements is not

28 excluded by the claim, which is written in an open manner. Google argues that Java Card does

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1   not practice the '702 patent for some of the same reasons that Google argues that the accused

2   Android functionality does not practice the '702 patent, namely that the .CAP file created by the

3   use of Java Card is not comprised of "reduced class files" that contain what remains after

4   duplicate constants have been removed from the class files. Google contends that the .CAP file

5   does not contain reduced class files that contain reduced constant pools. The parties therefore

6   stipulate as follows:

7   If the accused Android functionality infringes the '702 patent, then Oracle's Java Card

8   platform 2.1 product and subsequent versions practice the '702 patent.

9   **B.**   **'104 patent**

10   There is a dispute between the parties as to the proper application of the claims of the '104

11   patent. Oracle contends that Oracle's Java products do practice the '104 patent because data

12   references in the intermediate form object code instructions of Java class files are "symbolic

13   references" as the phrase was construed by the Court because they are platform-independent and

14   "identify data by a name other than the numeric memory location of the data," which would be

15   different on different computers. Oracle contends that Google's argument is inconsistent with

16   both the Court's claim construction and the manner in which Google's invalidity expert has

17   applied the claims to the prior art. Google argues that Oracle's Java products do not practice the

18   '104 patent for some of the same reasons that Google argues that the accused Android

19   functionality does not practice the '104 patent, namely that the intermediate form object code

20   instructions used in Oracle's Java products do not "contain[] one or more symbolic references."

21   Google contends that the Java bytecode instructions in Oracle's Java products contain numeric

22   references (i.e., indices), and not symbolic references. Google further observes that it is common

23   for validity experts to take a broader view of the patent claims (which may be consistent with

24   what the patentee is asserting in terms of infringement) than non-infringement experts. The

25   parties therefore stipulate as follows:

26   If the accused Android functionality infringes the '104 patent, then the following Oracle

27   products practice the '104 patent: JDK 1.0 and subsequent versions; JRE 1.1.1 and subsequent

28   versions; HotSpot 1.0 and subsequent versions; Java SE for Embedded 1.4.2_11 and subsequent

1   versions; J2EE 1.2 (later called Java EE) and subsequent versions; Java Real Time 1.0 and

2   subsequent versions; CDC RI 1.0 and CDC HI 1.0 and subsequent versions of each; CDC AMS

3   1.0, 1.0_1, and 1.0_2 (Personal Basis Profile and Personal Profile versions); Personal Profile RI

4   1.0 and subsequent versions; Personal Profile HI 1.1.1; Personal Basis Profile RI 1.0 and

5   subsequent versions; Personal Basis Profile HI 1.1.1; Foundation Profile 1.0 and subsequent

6   versions; CDC ToolKit 1.0 or Java ME SDK 3.0 EA and subsequent versions; CLDC RI 1.0 and

7   1.1; WTK 1.0 or Java ME SDK 3.0 EA and subsequent versions; CLDC HI 1.0 and subsequent

8   versions; Oracle Java Wireless Client (formerly Sun Java Wireless Client) 1.0 and subsequent

9   versions; PersonalJava 1.0 and subsequent versions; EmbeddedJava 1.0 and subsequent versions;

10   JavaOS 1.0 (and variants, including Java PC) and subsequent versions; and Java Card connected

11   platform 3.0 and subsequent versions.

C.   '205 patent

13   There is a dispute between the parties as to the proper application of the claims of the '205

14   patent. Oracle argues that its Java products and Android do practice the '205 patent, and that

15   Google's argument is based on a claim construction position that Google waived and that is

16   inconsistent with both the plain meaning of the phrase and the manner in which Google's

17   invalidity expert has applied the claims to the prior art. Google argues that Oracle's Java

18   products do not practice the '205 patent for some of the same reasons that Google argues that the

19   accused Android functionality does not practice the '205 patent, namely that Oracle's Java

20   products do not "generat[e], at runtime, a new virtual machine instruction." Google contends that

21   Oracle's Java products use instructions that are pre-existing virtual machine instructions (i.e.,

22   bytecode) with defined meanings such that these instructions are neither "new" nor "generated."

23   Google further observes that it is common for validity experts to take a broader view of the patent

24   claims (which may be consistent with what the patentee is asserting in terms of infringement)

25   than non-infringement experts. The parties therefore stipulate as follows:

26   If the accused Android functionality infringes the '205 patent, then the following Oracle

27   products practice the '205 patent: JDK 1.2 and subsequent versions; JRE 1.2 and subsequent

28   versions; HotSpot 1.0 and subsequent versions; Java SE for Embedded 1.4.2 and subsequent

1   versions; J2EE 1.2 (later called Java EE) and subsequent versions; Java Real Time System 1.0

2   and subsequent versions; CDC HI 1.1.1 and subsequent versions; Personal Profile HI 1.1.1;

3   Personal Basis Profile HI 1.1.1; CDC AMS 1.0, 1.0_1, and 1.0_2 (Personal Basis Profile and

4   Personal Profile versions); CLDC HI 1.1 and subsequent versions; and CLDC RI 1.1.1.

5   <div align="center">**D.   '720 patent**</div>

6   As reflected in the related claim-construction briefing, there is a dispute between the

7   parties as to the proper interpretation of the claims of the '720 patent. Oracle argues that

8   "obtain[ing] a representation of at least one class from a source definition provided as object

9   oriented program code" covers loading from class files and other object code. Google argues that

10 "obtain[ing] a representation of at least one class from a source definition provided as object

11 oriented program code" requires "compiling object oriented source code." In light of the pending

12 claim construction issue, the parties stipulate as follows:

13 If the Court adopts Oracle's proposed construction, then Oracle's CDC AMS product

14 practices the '720 patent.   On the other hand, if the Court adopts Google's proposed construction,

15 then Oracle's CDC AMS product does not practice the '720 patent.

16 <div align="center">**E.   '520 patent**</div>

17 <div align="center">**1.   Oracle's CLDC HI 1.1.3 and CLDC RI 1.1.1 products**</div>

18 There is a dispute between the parties as to the proper application of the claims of the '520

19 patent. Oracle maintains that its CLDC HI 1.1.3 and CLDC RI 1.1.1 products and Android

20 practice the asserted claims, because both interpret class initialization code to identify the static

21 initialization of the array. Google argues that the Oracle products do not practice the '520 patent

22 for some of the same reasons that Google argues that the accused Android functionality does not

23 practice the '520 patent, namely that the Oracle code at issue uses parsing or pattern matching,

24 rather than simulation of execution, to identify the initialization of a static array. The parties

25 therefore stipulate as follows:

26 If the accused Android functionality infringes the '520 patent, then Oracle's CLDC HI

27 1.1.3 and CLDC RI 1.1.1 products and subsequent versions practice the '520 patent.

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II.   DISPUTED PRODUCTS

A.   '520 patent

1.   Oracle's Java Card products

The parties dispute whether Oracle's Java Card products create "an instruction" within the meaning of the claims of the '520 patent. This is a technical dispute separate and distinct from the allegations involving the accused Android functionality.

Oracle contends that when the Java Card converter stores a value indicating the presence of static array initialization data, the array type, the array size, and the initialization values in the Static Field Component of the output .CAP file (Java Card™ 2.1.1 Virtual Machine Specification 100-101 (rev. 1.0, 2000), it creates "an instruction" as claimed in the '520 patent.

Google contends that, when creating a .CAP file, the Java Card converter does not create "an instruction" within the meaning of the claims of the '520 patent. Rather, the converter itself statically initializes the array and stores the initialized data value into the .CAP file. (*See* Z. Chen, Java Card Technology for Smart Cards, section 3.3.2 (Prentice Hall 2000).)

1   Dated: February 21, 2012   MORRISON & FOERSTER LLP

2
                                                By: /s/ Marc David Peters
3
                                                MORRISON & FOERSTER LLP
4   MICHAEL A. JACOBS (Bar No. 111664)
                                                mjacobs@mofo.com
5   MARC DAVID PETERS (Bar No. 211725)
                                                mdpeters@mofo.com
6   DANIEL P. MUINO (Bar No. 209624)
                                                dmuino@mofo.com
7   755 Page Mill Road
                                                Palo Alto, CA 94304-1018
8   Telephone: (650) 813-5600
                                                Facsimile: (650) 494-0792
9
                                                BOIES, SCHILLER & FLEXNER LLP
10   DAVID BOIES (Admitted *Pro Hac Vice*)
                                                dboies@bsfllp.com
11   333 Main Street
                                                Armonk, NY 10504
12   Telephone: (914) 749-8200
                                                Facsimile: (914) 749-8300
13   STEVEN C. HOLTZMAN (Bar No. 144177)
                                                sholtzman@bsfllp.com
14   1999 Harrison St., Suite 900
                                                Oakland, CA 94612
15   Telephone: (510) 874-1000
                                                Facsimile: (510) 874-1460
16
                                                ORACLE CORPORATION
17   DORIAN DALEY (Bar No. 129049)
                                                dorian.daley@oracle.com
18   DEBORAH K. MILLER (Bar No. 95527)
                                                deborah.miller@oracle.com
19   MATTHEW M. SARBORARIA (Bar No.
                                                211600)
20   matthew.sarboraria@oracle.com
                                                500 Oracle Parkway
21   Redwood City, CA 94065
                                                Telephone: (650) 506-5200
22   Facsimile: (650) 506-7114

23   *Attorneys for Plaintiff*
                                                ORACLE AMERICA, INC.
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Dated: February 21, 2012   KEKER & VAN NEST LLP

By: /s/ Eugene M. Paige

SCOTT T. WEINGAERTNER (*Pro Hac Vice*)
sweingaertner@kslaw.com
ROBERT F. PERRY
rperry@kslaw.com
BRUCE W. BABER (*Pro Hac Vice*)
bbaber@kslaw.com
1185 Avenue of the Americas
New York, NY 10036-4003
Telephone: (212) 556-2100
Facsimile: (212) 556-2222

DONALD F. ZIMMER, JR. (SBN 112279)
fzimmer@kslaw.com
CHERYL A. SABNIS (SBN 224323)
csabnis@kslaw.com
KING & SPALDING LLP
101 Second Street - Suite 2300
San Francisco, CA 94105
Telephone: (415) 318-1200
Facsimile: (415) 318-1300

GREENBERG TRAURIG, LLP
IAN C. BALLON (SBN 141819)
ballon@gtlaw.com
HEATHER MEEKER (SBN 172148)
meekerh@gtlaw.com
1900 University Avenue
East Palo Alto, CA 94303
Telephone: (650) 328-8500
Facsimile: (650) 328-8508

KEKER & VAN NEST LLP
ROBERT A. VAN NEST (SBN 84065)
rvannest@kvn.com
CHRISTA M. ANDERSON (SBN184325)
canderson@kvn.com
DANIEL PURCELL (SBN 191424)
dpurcell@kvn.com
633 Battery Street
San Francisco, CA 94111
Telephone: (415) 391-5400
Facsimile: (415) 397-7188

Attorneys for Defendant
GOOGLE INC.

SUPP. JOINT STATEMENT REGARDING ORACLE PRODUCTS PRACTICING PATENTS
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ATTESTATION

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    I, Marc David Peters, am the ECF User whose ID and password are being used to file this

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JOINT STATEMENT REGARDING ORACLE PRODUCTS PRACTICING PATENTS. In

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compliance with General Order 45, X.B., I hereby attest that Eugene M. Paige has concurred in

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this filing.

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Date: February 21, 2012   /s/ Marc David Peters

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